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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/775,039	02/09/2004	Kevin P. Parker	PRKR-4600	6907
<div>7590 07/16/2007</div> <div>Philip A. Girard GIRARD & EQUITZ LLP Suite 1110 400 Montgomery Street San Francisco, CA 94104</div> <div>EXAMINER NICHOLSON III, LESLIE AUGUST</div> <div>ART UNIT PAPER NUMBER 3651</div> <div>MAIL DATE DELIVERY MODE 07/16/2007 PAPER</div>				

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/775,039	Applicant(s) PARKER ET AL:	
	Examiner Leslie A. Nicholson III	Art Unit 3651	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 June 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-59 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-26, 28, 30-44 and 46-58 is/are allowed.
- 6) ☒ Claim(s) 27, 29, 45, 59 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed 6/15/2007 have been fully considered but they are not persuasive. Applicant argues "although 37 CFR 1.75(c) requires the dependent claims to further limit a preceding claim, this rule does not apply to product-by-process claims". In response, as previously corrected explained in the action filed 1/17/2007, the claims fail the infringement test and are improper dependent claims as described in MPEP 608.01(n) III. See ¶2.

Applicant further argues claims 27,29,45,59 all comply with the provisions of 35 USC 112 1st paragraph. In response, the Examiner disagrees. The passages and figures cited by the Applicant show a sheet that is in a stack of sheets. The specification does not disclose the method performed on a single independent sheet, but only on a stack of sheets having a plurality of single sheets. See ¶2.

Applicant further argues claims 27,29,45,59 are patentable over Fogg and Ackley. In response, MPEP 2113 recites "Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process". See ¶6,7.

Claim Objections

2. Claims 27,29,45,59 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim.

Applicant is required to cancel the claims, or amend the claims to place the claims in proper dependent form, or rewrite the claims in independent form.

The test as to whether a claim is a proper dependent claim is: it shall include every limitation of a claim from which it depends (35 U.S.C. 112, fourth paragraph). In other words, it shall not conceivably be infringed by anything that would not also infringe the basic claim (The Infringement Test, see M.P.E.P 608.01(n) III). In this instant case, it is conceivable to infringe dependent product claim without infringing the independent process claim, i.e. see 35 U.S.C 102/103 rejections below. Therefore, claims 27, 29, 45, and 59 fail the infringement test and are improper dependent claims.

In response to Applicant's arguments and the cited case law Scripps Clinic & Research Foundation v Genentech Inc., 927 F.2d 1565, (Fed Cir 1991), the product of claim 13 therein can only be made by the independent process claim 1. Therefore, the dependent product claim 13 is a proper dependent claim. It passed the infringement test. In other words, one could not infringe the dependent product claim 13 without infringing the independent process claim 1.

Applicant's claims 27, 29, 45, and 59, on the other hand, could be made by different process steps including Fogg 2,646,726 and Ackley 1,642,866 processes (see rejections below). Hence, the product claims could be infringed while the process

Art Unit: 3651

claims are not. Applicant's dependent product claims do not pass the infringement test and therefore, are improper independent claims. See ¶1.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 27,29,45,59 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The specification does not provide support for a sheet being conditioned per the claimed process. The specification only provided enablement for conditioning the edge of a stack of sheets. The process of conditioning a single sheet as claimed was not supported in the specification. It is true that a stack of sheets would contain plurality of single sheets. However, the current language of the claims presents a non-enablement problem because one of ordinary skill in the art would not be able to condition just a single sheet per Applicant's claimed process. It is recommended that -- a stack of sheets having plurality of single sheets -- be used instead of just "a sheet." See ¶1

Claim Rejections - 35 USC § 102/103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 27,29,45,59 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Fogg 2,646,726.

Fogg '726 discloses a sheet per claimed invention. See MPEP 2213 and ¶1.

7. Claims 27,29,45,59 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Ackley 1,642,866.

Ackley '866 discloses a sheet per claimed invention. See MPEP 2113 and ¶1.

Allowable Subject Matter

8. Claims 1-26, 28,30-44,46-58 are allowable over the prior art of record.

Conclusion

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the

Art Unit: 3651

shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Leslie A. Nicholson III whose telephone number is 571-272-5487. The examiner can normally be reached on M-F, 8:30 AM - 5 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gene Crawford can be reached on 571-272-6911. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

L.N.
7/9/2007


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